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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

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Application of :
Akira KUME et al. :
Appln. No. 10/670,722 : Art Unit: 3723
Filed: September 25, 2003 : Examiner: Bryan R. Muller
For: JIG PLATE, END FACE :
POLISHING MACHINE HAVING :
JIG PLATE, AND END FACE :
POLISHING METHOD :
(as amended) : Docket No. M004-5129

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REPLY BRIEF UNDER 37 C.F.R §41.41

S I R:

Pursuant to 37 C.F.R. §41.41, appellants present this brief in reply to the Examiner's Answer ("EA") dated June 30, 2006.

In the brief on appeal ("BOA") filed May 10, 2006, appellants presented arguments addressing the rejection of claims 21-24, 28-30 and 35-38 under 35 U.S.C. §103(a) raised by the Examiner in the final Office Action. In responding to

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appellants' arguments, the Examiner has raised new points of argument with respect to the prior art rejection of the claims. These new points of arguments are addressed below.

1. The Examiner's Contention that the Rejection of Claims 21, 28, 35 and 37 Under 35 U.S.C. §112, First and Second Paragraphs, in the Final Office Action Have Not Been Withdrawn by the Examiner

In the EA (pgs. 2-3), the Examiner contends that the rejections of claims 21, 28, 35 and 37 under 35 U.S.C. §112, first and second paragraphs, in the final Office Action have not been withdrawn by the Examiner. Appellants respectfully disagree with the Examiner's contention.

In the Advisory Action dated February 28, 2006, the Examiner advised on page 2 of the Advisory Action that the arguments and amendments presented in the amendment after final filed February 8, 2006 overcame the rejections of claims 21, 28, 35 and 37 under 35 U.S.C. §112, first and second paragraphs. Accordingly, the Section 112 grounds of rejection are not under review on appeal because they have effectively been withdrawn by the Examiner.

Appellants respectfully request that if the Examiner intends to reinstate the rejections of claims 21, 28, 35 and 37 under 35 U.S.C. §112, first and second paragraphs, than that such intention be communicated to appellants in response to this reply brief.

2. Status of Claims 35-38 Presented in Appendix

The Examiner contends that the version of claims 35-38 presented in the Appendix to the BOA contain substantial errors because these claims are as presented in the February 8 amendment after final (EA, pgs. 3-5). Appellants respectfully disagree with the Examiner's contention.

In the February 8 amendment after final, appellants amended claims 35 and 37 only to overcome the rejection under 35 U.S.C. §112, first and second paragraphs. Claims 36 and 38 were amended only to conform to the amendment to claims 35 and 37, respectively. In the February 28 Advisory Action, the Examiner advised that the amendment to claims 35-38 in the amendment after final would be entered for purposes of appeal (see Section 7 of Advisory Action). Accordingly, the version of claims 35-38 presented in the BOA is the correct version presented for review on appeal.

2. Rejection of Claims 21-24, 28-30¹ and 35-38 Under 35 U.S.C. §103(a)

The applicable Examiner's contentions in the Response to Argument section of the EA (section 10, pgs. 9-19) are addressed below.

¹ The Examiner has withdrawn claim 31 from further consideration as being directed to a non-elected invention (Final Office Action, pg. 2). Claim 31 is therefore not under consideration in this appeal.

A(1)

Appellants' position with respect to the reliance on the teachings in the reference to Ohno and the Examiner's motivation for modifying Yamada in view of Ohno are as set forth on pages 12-14 of the BOA.

A(2)

The Examiner contends that the engaging portion 2, 2a in Fig. 3 of Yamada "is considered to be a part of the holding member". Appellant respectfully disagree.

As pointed out in the BOA, while the Examiner is correct in construing the adapter hook 2a as an engaging portion which detachably engages the connecting member 27 of the optical connector plug, as shown in Figs. 3 and 7 of Yamada, the engaging portion 2a does not form part of the holding member 4 (i.e., the engaging portion 2a does not form part of the pair of adapter-spring plates 4), as the Examiner contends. Stated otherwise, the engaging portion or adapter hook 2a in Yamada forms part of the adapter 2, not part of the holding member 4.

Thus, contrary to the Examiner's contention in the final Office Action, Yamada does not disclose or suggest a jig plate comprised of a holding member having an engaging portion for detachable engagement with a connecting member of the optical connector plug to removably support the optical connector plug, as recited in independent claim 21.

A(4)

The Examiner contends that the disclosure in the present application does not provide support for the subject matter recited in claim 21, and that the disclosure does not describe any structure that provides for the rotation of the ferrule in the opposite direction to the polishing surface. Appellants respectfully disagree with the Examiner's contention.

As described in the specification (pgs. 10-11) with reference to Fig. 1, the polishing member 27 having the polishing surface is provided on top of a platen 25 which is rotated clockwise via a rotary shaft 23 connected to a transmission shaft 20 driven by drive and driven gears 18, 19 rotationally driven by a motor 17. The specification further discloses that the connector plug 100, and thus the ferrule 110, is rotated in a direction opposite to the rotating direction of the platen 25 during a polishing operation (Spec., pg. 20, lines 4-10; pg. 22, line 20 to pg. 23, line 5; pg. 23, lines 7-13). The structure which provides for rotation of the connector plug 100 includes a bearing cylinder 22 of a polishing machine body 21 which is fitted on the transmission shaft 20 (Spec., pg. 11, lines 2-4).

A(5)

The Examiner contends that since the conventional method, and corresponding structure for accomplishing such method, disclosed in Figs. 2A and 2B of Ohno is an "acceptable" method for providing an optical fiber with a smooth convex tip (EA, pg. 12, lines 13-16), one of ordinary skill in the art would have been led to modify Yamada in view of Ohno to incorporate the structure for performing such conventional method. Appellants respectfully disagree.

The Examiner has not provided any evidence, nor a convincing line of reasoning, showing that the conventional method disclosed in Figs. 2A, 2B of Ohno is an "acceptable" method which would have led one of ordinary skill in the art, at the time the invention was made, to modify the structure and operational method in Yamada to arrive at the claimed invention. Again, as set forth in the BOA, the teaching in Figs. 2A-2B of Ohno is not adequate to support the Section 103 rejection of independent claim 21 because one of ordinary skill in the art would be led away from rather than adopt or follow such teaching in Ohno. More specifically, while disclosing in Fig. 2A a conventional method of rotating a ferrule and a polishing plate in opposite directions during a polishing operation to provide the end face of the ferrule with a convex tip, Ohno immediately qualifies such disclosure

by explicitly warning that such conventional method "has some problems yet to be solved" (col. 4, lines 16-17). Ohno explicitly describes these problems in col. 1, lines 46-63.

A(1), A(3) and A(6)-A(10)

Appellants' position with respect to the issues addressed by the Examiner in A(1), A(3) and A(6)-A(10) are as set forth in the BOA.

In light of the arguments and showing made herein and the arguments presented in the BOA, appellants respectfully submit that the rejections of claims 21-24, 28-30 and 35-38 under 35 U.S.C. §103(a) as being unpatentable over the various combinations of the references to Yamada and Ohno are in error and should not be sustained.

Respectfully submitted,

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I hereby certify that this correspondence is being deposited with the United States Postal Service as first-class mail in an envelope addressed to: Mail Stop Appeal Brief-Patents, COMMISSIONER FOR PATENTS, P.O. Box 1450, Alexandria, VA, 22313-1450, on the date indicated below.

 Donna Riccardulli

Name


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AUGUST 30, 2006

Date